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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,279	06/09/2000	Katayoon Dehesh	15597/01/US	3330

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ARNOLD & PORTER  
IP DOCKETING DEPARTMENT; RM 1126(b)  
555 12TH STREET, N.W.  
WASHINGTON, DC 20004-1206

EXAMINER

STEADMAN, DAVID J

ART UNIT PAPER NUMBER

1652

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SM

**Advisory Action**

Application No.

09/591,279

Applicant(s)

DEHESH ET AL.

Examiner

David J Steadman

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 4-7 and 29-64.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

**ADVISORY ACTION**

[1] Claims 4-7 and 29-64 are pending in the application.

[2] Receipt of a paper copy of the sequence listing and a statement that the computer readable form and paper copy of the sequence listing are identical, filed September 25, 2003, is acknowledged.

[3] The request for reconsideration in the amendment filed September 25, 2003 has been considered, however the amendment does not place the application in condition for allowance. While the amendment to the claims would appear to overcome the rejections under 35 USC 112, second paragraph as set forth in items 7-10 and the rejection under 35 USC 112, first paragraph as set forth in item 11 of the Office action mailed August 22, 2003, the amendment has not been entered because the claims as amended present new issues requiring further consideration and at least a new rejection under 35 USC 112, second paragraph. See MPEP § 714.13 regarding non-entry of an after final amendment.

[4] It is noted that claim 30 has been amended to recite "wherein said substitution is of a hydrophobic residue to a larger hydrophobic residue". This amendment renders certain claims confusing and unclear. For example, in claims 37 and 38, phenylalanine is replaced with isoleucine or methionine, respectively. One of ordinary skill in the art recognizes that phenylalanine is larger than either of isoleucine or methionine. For example, Chothia (*Ann Rev Biochem* 53:537-572) discloses the mean volume of amino acid residues buried in a protein (page 545, Table 2). Chothia teaches that phenylalanine has a mean volume of 203 Å<sup>3</sup>, while isoleucine has a mean volume of


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169 Å<sup>3</sup> and methionine has a mean volume of 171 Å<sup>3</sup>. Thus, it is unclear as to how replacing phenylalanine with either of isoleucine or methionine would be considered substitution of a hydrophobic residue to a larger hydrophobic residue.

[5] Applicant's arguments have been fully considered. However, in view of the non-entry of the amendment filed September 25, 2003, applicants' arguments are not found persuasive for the reasons of record and the rejections and/or objections as set forth in the Office action mailed August 22, 2003.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934. The Examiner can normally be reached Monday-Friday from 7:00 am to 5:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX number for submission of official papers to Group 1600 is (703) 308-4242. Draft or informal FAX communications should be directed to (703) 746-5078. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman, Ph.D.  
Patent Examiner  
Art Unit 1652



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